

### **REMARKS**

Claims 1-24 are pending in this application. Claims 14-21 have been withdrawn.

Claims 1 and 7 have been amended to recite "a racemic diad fraction [r] of 0.12 to 0.82~~0.12 to 0.50~~" and "a racemic diad fraction [r] of 0.12 to 0.82~~0.51 to 0.88~~,"

respectively. Support for these amendments can be found in Examples 6 and 7 of the Specification. Further, new claim 24 has been added to recite the invention of original claim 1, with the only difference being the upper limit of the racemic diad fraction [r].

Original claim 1 recited 0.88 as the upper limit of the racemic diad fraction [r], whereas new claim 24 recites 0.82.

The claim amendments do not present new matter or raise new issues. The applicants respectfully request reconsideration of the instant application in view of the preceding amendments and the following remarks.

### ***The Claimed Invention***

Claims 1-13 and 22-24 cover an emulsion composition of modified polypropylene. In particular, the claimed emulsion composition contains polypropylene with a racemic diad fraction [r] in a range of 0.12 to 0.82, which allows for highly solubility in an organic solvent. According to Examples 6 and 7 of the Specification, an upper limit of 0.82 of the racemic diad fraction [r] resulted in unexpected improvements in terms of dispersion and emulsion stability.

**Claims 7-13 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wakabayashi, in view of Okamoto and Hisada.**

The applicants respectfully traverse this rejection.

Pursuant to 35 U.S.C. §103(c), **Wakabayashi** fails as prior art because, at the time the instant invention was made, both **Wakabayashi** and the claimed invention were owned by a common entity, Tonen Chemical Company.

The effective filing date of the instant application is July 8, 2003, based on the priority application of JP 2003-193709. Therefore, **Wakabayashi**'s prior art date is the U.S. filing date of June 30, 2003, based on 35 U.S.C. §102(e). However, pursuant to 35 U.S.C. §103(c), a reference by another which may qualify as prior art under §102(e) fails as prior art provided that the reference and the claimed invention were owned by a common entity at the time the claimed invention was made.

**Wakabayashi** is owned by Tonen Chemical Corporation as a result of an assignment from the inventors. Furthermore, the priority application of **Wakabayashi**, JP 2002-191288, shows that Tonen Chemical Corporation owned the subject matter of **Wakabayashi** on June 28, 2002, the filing date. (A copy of the front page of JP 2002-191288 is enclosed).

As for the instant application, the priority application, JP 2003-193709, shows that Tonen Chemical Corporation owned the claimed invention on the filing date, July 9, 2003. (A copy of the front page of JP 2003-193709 is enclosed).

Therefore, at the constructive time of invention, July 9, 2003, Tonen Chemical Corporation owned both **Wakabayashi** and the claimed invention. Accordingly, **Wakabayashi** fails as prior art.

Without **Wakabayashi**, there is absolutely no teaching in the combined disclosure of **Okamoto** and **Hisada** sufficient to render the claimed invention obvious. Therefore, the applicants respectfully request reconsideration and withdrawal of the rejection of claims 7-13 and 23 under 35 U.S.C. §103(a).

**Claims 1-6 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wakabayashi, in view of Okamoto and Hisada.**

The applicants respectfully traverse this rejection.

As discussed above, **Wakabayashi** fails as prior art, and **Okamoto** and **Hisada**, alone, are insufficient to render the claimed invention obvious. Therefore, the applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-6 and 22 under 35 U.S.C. §103(a).

**Claims 7-13 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tomita, et al., in view of U.S. Patent No. 4,442,243 to Woodhams.**

The applicants respectfully traverse this rejection.

**Tomita** fails to render the claimed invention obvious because the reference fails to disclose a racemic diad fraction [r] of 0.12 to 0.82 and, in fact, **teaches away from a racemic diad fraction [r] less than 0.8366.**

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference . . . would be led in a direction divergent from the path that was taken by the applicant." *In re Gurney*, 27 F.3d 551, 553 (Fed. Cir. 1994). **Tomita** discloses a

racemic triad  $[rr]$  of 0.7, which approximately corresponds to a racemic diad fraction of  $\sqrt{0.7} = 0.8366$ . Given that **Tomita** teaches a triad  $[rr]$  fraction of “**at least**” 0.7, the reference does not provide any teaching for a triad  $[rr]$  fraction **less than** 0.7.

The unsaturated polymers used in the present invention comprise at least one of the  $\alpha$ -olefins having 3 to 20, preferably 3 to 12 carbon atoms and have an olefinic unsaturated bond at its terminus and a **triad  $[rr]$  fraction of at least 0.7, preferably at least 0.75 and more preferably at least 0.8. The upper limit of the  $[rr]$  fraction is preferably 1, more preferably 0.99.**

(**Tomita**, col. 3, lns. 22-27). Therefore, **Tomita**’s disclosure of a racemic diad fraction of **at least**  $\sqrt{0.7} = 0.8366$  teaches away from the claimed upper limit racemic diad fraction  $[r]$  of 0.82, which is **less than** 0.8366.

**Woodhams** fails to make up for the deficiency in **Tomita**’s disclosure.

Without disclosing an upper limit racemic diad fraction  $[r]$  of 0.82, there is no way that **Tomita** and **Woodhams**, combined, render the claimed invention obvious.

Accordingly, the applicants respectfully request reconsideration and withdrawal of this rejection.

**Claims 1-6 and 22 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.**

The applicants respectfully submit that this rejection is moot in light of the claim amendments. Specifically, the claims no longer recite a racemic diad fraction  $[r]$  of 0.50. Accordingly, the applicants request reconsideration and withdrawal of this rejection.

**Claims 7-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of Wakabayashi, in view of Okamoto and Hisada.**

A Terminal Disclaimer is submitted in response to this rejection. Accordingly, the applicants respectfully request that this rejection be reconsidered and withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Dated: April 23, 2008

Respectfully submitted,

By 

James E. Armstrong, IV

Registration No.: 42,266

EDWARDS ANGELL PALMER & DODGE  
LLP

P.O. Box 55874, Boston, MA 02205

(202) 478-7370

Attorneys/Agents For Applicant

Attachments: Copies of the 1<sup>st</sup> page of priority documents (2 sheets)